



03-28-06

IFW

Appl. No 10/707,819

RESPONSE TO OFFICE ACTION MAILED FEBRUARY 27, 2006

I have carefully considered the Office Action mailed on February 27, 2006 and submit the following response: I elect Class 705, subclass 51 with traverse.

Under MPEP 806.05 (h), *a product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown:*

- (A) *the process of using as claimed can be practiced with another materially different product.* In the instant case, the process claimed in 28-38 can not be used with another materially different product. For example, the step of **conducting an alteration test** of the medium can not be verifiably performed unless the medium claimed in 1-11, 39 is used.
- (B) *the product as claimed can be used in a materially different process.* The Patent Office erred in determining that the product (the medium claimed in 1-11, 39) can be used with a process, other than the one claimed in 28-38. In fact, the essence of the invention is that unless the method claimed in 28-38 is followed, the end user will **not** be able to use the medium claimed in 1-11, 39. For example, the conventional reading of the medium can not be performed by a designated data rendering system unless the alteration of the medium takes place (please refer to Fig 8 for top-level logic governing the designated data rendering system). Claim 1 has been amended for further clarity on this point.

The Patent Office erred in applying MPEP 806.05 (g). MPEP 806.05 (g) governs *an apparatus and a product made by the apparatus*. The medium claimed in 1-11, 39 is **not a product made by** the designated data rendering system claimed in 12-27, 40-42.

Claims 1-11, 39 are drawn to a data storage medium comprising means for subsequent alteration by an external influence in a manner detectable by a designated data rendering system. Only the designated data rendering system (claimed in 12-27, 40-42) comprising an **alteration detector** for determining an alteration status of the medium can detect the permanent alteration of the medium claimed in 1-11, 39. Thereby, Claims 1-11, 39 and Claims 12-27, 40-42 can not be regarded as "*two or more independent and distinct inventions*" under 35 U.S.C. § 121.

The data storage medium claimed in 1-11, 39 comprises means for **verifiable** alteration by the data rendering system claimed in 12-27, 40-42. Any data storage medium can be altered (for example, scratched). The novel medium claimed herein can be altered in a way **detectable** only by a designated data-rendering system having an **alteration detector**.

Under MPEP 806.05 (e), *a process and apparatus for its practice can be shown to be distinct inventions, if either*

- (A) *the process as claimed can be practiced by another materially different apparatus or by hand.* In the instant case, the method claimed in 28-38 can **not** be practiced by another materially different apparatus. Specifically, the steps of delivering said medium to end user's data rendering system, said system **restricting access** to at least part of the content **prior to said medium alteration**; and **conducting an alteration test** of the medium can not be practiced unless the apparatus claimed in 12-27, 40-42 is used.
- (B) *The apparatus as claimed can be used to practice another and materially different process.* As mentioned in the paragraph 0037 of the present application, for the claimed apparatus to be commercially viable, it **must** be backward-compatible. The back-compatibility is also the

subject of Claim 14 of the present application. The system claimed in 12-27, 40-42 can indeed be used to read a conventional CD while **not enforcing the content usage agreement**. However, the claimed apparatus can **not** be used to practice another and materially different process to accomplish the **same purpose**, i.e. to **enforce** restrictive covenants of **the content usage agreement**. The claimed apparatus can only be used to practice another and materially different process to accomplish the **purpose different** from the one stated in the application. Under Patent Office's current interpretation of the guideline, no electric device could be patented along with the process, since every electric device can be used as a small, portable heater, i.e. can be used to practice another materially different process.

The restriction imposed on the present application is **not consistent** with the prior practice by the Patent Office in the field of the invention:

1. A **method**, an **apparatus**, and a computer readable **storage medium** for selling digital content are claimed in a single US patent 6,978,256 by Hitachi, Ltd.
2. A secure digital image projection **system**, a secure digital data media player (**apparatus**), and a secure data storage **medium** are claimed in a single US patent 7,006,995 by Texas Instrument Inc.
3. A computer implemented **method** of selling digital contents, an **apparatus** for selling digital contents, a **medium** for recording a program, a computer readable storage **medium** are claimed in a single US patent 6,928,423 by Hitachi, Ltd.
4. A data processing **apparatus**, a data processing **method**, a data reading **apparatus**, and a data recording **apparatus** are claimed in a single US patent 7,013,078 by Sony Inc.
5. A reproduction **apparatus** and a reproduction **method** of digital video signal or audio signal are claimed in a single US patent 6,996,545 by Hitachi, Ltd.
6. A license devolution **apparatus** and a license devolution **method** are claimed in a single US patent 6,999,947 by Fujitsu, Ltd.
7. A copyright management **apparatus**, a **system** for distributing copyrighted works, a **method** for distributing copyrighted works, a **method** for managing copyrights for copyrighted works in a system, and a copyright management **system** are claimed in a single US patent 6,928,423 by Sony Inc.
8. A **method** and an **apparatus** of restricting a copy of digital information in a single US patent 6,990,584 by Pioneer Inc.
9. A **method** to deliver encrypted digital content and a computer readable **medium** containing programming instructions for delivery of encrypted digital are claimed in a single US patent 6,983,371 by IBM Inc.
10. A **method** of authentication, a contents-information sender **apparatus**, and a contents-information receiver **apparatus** are claimed in a single US patent 6,983,369 Victor Co. of Japan.

The prosecution of the above patents was not deemed to be *a serious burden on the examiner* under MPEP 808. Similarly, the prosecution of the present application does not impose *a serious burden on the examiner if the restriction is not required* under MPEP 808.

Claims 1, 14, 28, 40 have been amended for clarity:

Modified Claim1. A data storage medium readable only by a designated data rendering system, said medium comprising means for subsequent controlled and verifiable alteration by an external influence in

a manner detectable by a designated said data rendering system, said alteration permanently corrupting at least part of the stored data with the purpose of enforcing at least one restrictive covenant of the data usage agreement.

Modified Claim 12. An end user system for rendering content delivered on a removable data storage medium enabled for subsequent controlled and verifiable alteration by an external influence in a manner detectable by said system, said alteration permanently corrupting at least part of the content access data, said system storing at least part of the content access data and restricting access to at least part of the content prior to said medium alteration with the purpose of enforcing at least one restrictive covenant of a content usage agreement, the system comprising: a reader for reading the content of said medium; a memory cell for storing access data designated to be permanently corrupted as a result of said medium alteration; an alteration detector for determining an alteration status of said medium; a logic unit programmed to deny access to at least part of said content upon detecting at least one event out of a plurality of events comprising: an alteration of said medium has not been confirmed by said alteration detector, content access data is not present in said memory cell, at least one restrictive covenant of said content usage agreement is not satisfied.

Modified Claim 14. The end user system according to claim 12 further comprising means for compatibility with respect to the types of data storage media not requiring alteration but otherwise substantially analogous to the data storage medium requiring subsequent controlled and verifiable alteration permanently corrupting at least part of the stored data by an external influence in a manner detectable by said system.

Modified Claim 28. A method to distribute content stored on a removable data storage medium enabled for subsequent controlled and verifiable alteration by an external influence in a manner detectable by end user's data rendering system, said alteration permanently corrupting at least part of the content access data with the purpose of enforcing at least one restrictive covenant of a content usage agreement, said method comprising the steps of: recording content on said medium; recording access data on said medium; delivering said medium to end user's data rendering system, said system restricting access to at least part of the content prior to said medium alteration; storing at least part of the access data by said system; altering said medium to render at least part of the access data to be unreadable; conducting an alteration test of said medium; retrieving at least part of the content from said medium using the access data stored by said system.

Modified Claim 40. An end user system for rendering content delivered on an optically readable data storage medium enabled for subsequent controlled and verifiable alteration by a mechanical force in a manner detectable by said system, said alteration corrupting at least part of the content access data, said system storing at least part of the content access data and restricting access to at least part of said content prior to said medium alteration with the purpose of enforcing the content usage agreement, the system comprising: a reader for reading the content of said medium; a memory cell for storing part of the access data designated to be corrupted as a result of said medium alteration.

Since all of the asserted grounds for the restriction are successfully traversed, it is respectfully requested that the restriction for examination is removed.